



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/091,513

03/07/2002

Dean Moses

VIGN1690-1

8808

44654 7590 11/30/2010
SPRINKLE IP LAW GROUP
1301 W. 25TH STREET
SUITE 408
AUSTIN, TX 78705

EXAMINER

STRANGE, AARON N

ART UNIT

PAPER NUMBER

2448

MAIL DATE

DELIVERY MODE

11/30/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/091,513	Applicant(s) MOSES ET AL.	
	Examiner AARON STRANGE	Art Unit 2448	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,6-14,17,19-27,30-34 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-14,17,19-27,30-34 and 36-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20100804</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner would like to note that the present application has been reassigned to a new Examiner.
2. In the interest of expedited prosecution, the Examiner would like to recommend conducting an interview prior to filing a response to the present Office action. The Examiner feels that an interview would help foster a mutual understanding of the respective positions of Applicant and the Examiner, and assist in the identification of allowable subject matter and/or issues for appeal. If Applicant agrees that an interview would be beneficial, he/she is encouraged to contact the Examiner to schedule one.

Response to Arguments

3. Applicant's arguments filed 8/3/2010 have been fully considered but they are not persuasive.
4. With regard to claim 1, and Applicant's assertion that Stefik fails to disclose a reference that "contains information necessary to locate and invoke the object" (Remarks 9-10), the Examiner respectfully disagrees. As an initial matter, it is noted that the specification of the present application fails to describe a reference that "contains information necessary to locate and invoke" an object, as discussed in more detail below.

Nonetheless, Stefik's teaches or suggests a reference that "contains information necessary to locate and invoke" an object with which it is associated. Stefik's digital ticket is an indicator that the ticket holder is entitled to "some *specified* right, product or service" (emphasis added)(col. 4, ll. 8-11). Therefore, the ticket contains information necessary to locate any object with which it is associated because it specifies the right, product or service which it grants access to, thereby identifying the associated object and allowing a ticket holder to determine what rights they have when possessing a particular digital ticket.

Stefik further discloses that a digital ticket may be "presented to a digital ticket agent" and that the ticket may contain addressing information for locating a "special" ticket agent (col. 22, ll. 60-66). Therefore, the digital ticket may also contain information necessary to invoke a particular object, since the ticket must be punched by a particular ticket agent specified in the ticket before the object may be invoked.

Since Stefik's ticket identifies the right, product or service and, in at least some instances, identifies a particular ticket agent for punching the ticket before receiving access to a digital work, Stefik discloses a reference (digital ticket) that contains information necessary to locate and invoke a particular object.

Claim Objections

5. Claim 1 is objected to because of the following informalities: There appears to be a typographical error "the second site" in line 7. It appears that Applicant may have intended for the claim to recite "a second site". Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 4, 6-14, 17, 19-27, 30-34 and 36-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. With regard to claim 1, the specification fails to describe a reference that "contains information necessary to locate and invoke [an] object". The specification describes a "reference to the object", but provides no definition or supplemental explanation regarding the meaning of that term. The "reference to the object" in the specification is not described as containing information "necessary" for any purpose, including location or invocation of an associated object. As understood in the art, "references" to objects do not typically contain information "necessary" to locate or invoke an object, since objects may be directly located and invoked, without use of stored reference to the object.

Art Unit: 2448

9. Claims 14, 27 and 40 contain a substantially identical, and are rejected under the same rationale.

10. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 4, 6-14, 17, 19-27, 30-34 and 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (US 6,236,971) in view of Chang et al. (US 2002/0078377).

13. As per claim 1, Stefik teaches a method for sharing an object (digital work) comprising the steps of:

storing a reference (digital ticket) to the object in a first repository available to a first site (tickets may be stored and distributed among repositories)(col. 3, ll. 37-39; col. 51, ll. 42-44), wherein the reference to the object contains information necessary to

Art Unit: 2448

locate (identification information)(col. 4, ll. 8-11) and invoke (address information of special ticket agent)(col. 22, ll. 60-66) the object;

performing a first operation to store a duplicate of the reference to the object in a second repository associated with a second site (tickets can be copied to other repositories)(col. 23, ll. 4-5; col. 51, ll. 45-46);

making the object available to the second site (ticket holders can access associated objects and tickets can be refreshed upon transfer)(col. 23, ll. 4-25; col. 51, ll. 56-58);

wherein the first operation is in accordance with a first privilege granted as defined by a permission (permissions granted as a result of fee payment)(col. 51, ll. 63-65).

Stefik does not specifically disclose the object (digital work) being an invokable software object. However, it is known at the time of the invention to share/lease invokable software objects. Chang et al. discloses a system where invokable software objects can be leased for used over a distributed network (see fig.2d, fig.3, paragraph [0035]) . It would have been obvious for one of ordinary skill in the art at the time the invention was made to apply the teaching of Stefik to control the leasing of invokable software objects because it would have enabled the owner of a software object to specify usage and distribution rights to the software object (Stefik; Abstract; col. 4, ll. 6-14).

Art Unit: 2448

14. As per claim 4, Stefik teaches an operation to remove the object from the second site by removing the duplicate of the reference of the object from the second repository (col. 38, ll. 18-29)

15. As per claim 6, Stefik further discloses providing access to the duplicate of the reference of the object in the second repository (other repositories can request and receive the digital ticket).

16. As per claims 7-9, Stefik teaches access is in accordance with a second privilege (col. 11, ll. 33044; col. 44, ll. 8-23; col. 46, ll. 1-20) and storing in a third repository (the distributor repository, etc).

17. As per claims 10-11, Stefik teaches an operation to remove the object from a repository (col. 38, ll. 18-29).

18. As per claim 12, Stefik teaches storing references to child objects (col. 11, l. 58 to col. 12, l. 8).

19. As per claim 13, Stefik teaches excluding reference to a child object (apparent from col.12 ll. 21-38).

Art Unit: 2448

20. Claims 14, 17, 19-27, 30-34 and 36-39 are rejected under the same rationale as claims 1, 4 and 6-13, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

21. As per claim 40, it is rejected under similar rationale as for claim 1 above. Since the object (digital work) is originally stored in Stefik's "first repository", Stefik's "second repository" and "third repository" can 'share' a reference (digital ticket) to the object stored on the "first repository". Hence, the repositories comprise a shared repository as claimed.

22. As per claim 41, it is apparent that a second copy of the reference (digital ticket) can be made to another third repository if the ticket permits multiple copies.

23. As per claim 42, another third repository would be considered as part of a shared repository for the same rationale as stated for claim 40 above.

24. As per claim 43, Stefik teaches the reference (digital ticket) is copied from one repository to another (col. 51 l. 45, col. 4, ll. 37-40). The object (digital work) itself is not transferred to the repository until access to the object is requested using the reference (digital ticket). Hence, the object is not copied to the repository during the creation of the copy of the reference.

25. As per claim 44, Stefik does not specifically disclose storing object in a database remote from the shared repository. However, for reliability purposes, it is well known in the art to store data in a remote database for archival or backup. Hence, it would have been obvious for one of ordinary skill in the art to store the object in a remote database because it would have enabled backup of the object.

Conclusion

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2448

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Primary Examiner, Art Unit 2448